

Remarks/Arguments:

This is a reply to the office action of June 11.

We have amended claim 16 in line with the original disclosure, sections [0016] to [0020]. The other independent claim 25 has been similarly amended. Claims 21 to 23 have been cancelled, and claims 24 and 27 have been adapted to the new independent claims.

The substance of the independent claims has not been significantly altered. Therefore, we believe that no further search by the examiner should be necessary.

We note that novelty of the claims on file has been acknowledged. However, the claims remain rejected on the ground of obviousness. We respectfully disagree with the assessment of the examiner in the outstanding office action for the following reasons.

As an introduction, we would like to restate briefly the concept of this invention.

Protection of security documents against counterfeiting is an ever-continuing race, in which the originators and authorities attempt to remain one step ahead of the counterfeiters. It is of course well-known to protect security documents by means of security elements. The present invention is not related at all to a development of a new security element *per se*. Rather, security elements are in existence. It is also known to apply a plurality of different security elements to security document, in order to improve protection against counterfeiting. Nevertheless, since those security elements *per se* are known and more or less readily available to skilled counterfeiters, there is still a need for a further improvement of protection against counterfeiting.

The present invention provides a solution to that problem which is based on the following concept: the different constituting parts of a security document such as a bank note are manufactured at different locations. For example, the paper of a security document such as a bank note is provided by a certain manufacturer A, whereas other security elements such as a security thread or a printing ink to be applied onto specific portions of the security document are provided by other manufacturers B or C. All those security elements are unique. Each manufacturing step requires a certain skill, which is not easy to correctly reproduce by a counterfeiter. For example, it is not too trivial to insert a security thread into a security document.

In summary, there is a chain of manufacturing steps necessary to arrive at a final security document. In that chain, specific reliable manufacturers are involved. The present invention is now based on the finding that an improved protection against counterfeiting can be achieved if one is able to trace and thus verify the manufacturing chain in an easy way. Usually, a counterfeiter is not able to exactly reproduce all the manufacturing steps in the production chain of a security document. Therefore, counterfeiting can be verified by enabling the traceability of the manufacturing chain. According to the present invention, this is made possible by inserting the same security element into at least two different constituting parts of a security document. For example, the manufacturer of the bank note paper is provided with a same security element as e.g. the manufacturer of a security thread or a printing ink which is to be applied onto the bank note paper or security thread. These different manufacturers use the same security element for manufacturing the final security document. As mentioned above, the different manufacturing steps are carried out at different locations with specific different skills.

By providing an authenticator an easy way to verify whether the original constituting parts of the security document have been actually used, an improvement against counterfeiting is obtained.

To summarize, the present invention is based on the finding that if the same security element is provided in at least two different constituting parts of a security document in such a manner that the identity of the security elements can be easily verified, a further improvement against counterfeiting is achieved: for an authenticator, it has now become possible to trace the manufacturing chain for the security document.

Counterfeiting is proven if in the different constituting parts of the security document not the same security element is used. This would indicate that the security document was not manufactured according to the original manufacturing chain.

The examiner has cited Plaschka as a reference allegedly rendering obvious the subject matter of the present invention. We respectfully disagree. First of all, it has now been accepted that Plaschka does not clearly and unambiguously disclose the subject matter of the present invention. Thus, in order to arrive at the present invention, one would have to modify the teaching of Plaschka. However, there is no suggestion or motivation in Plaschka to modify its teaching. Plaschka is clearly related to a different problem to be solved. This is absolutely clear from the passage in column 1, lines 53 to 59 of Plaschka: "the invention is based on the surprisingly simple idea of not improving the machine-readability of the optically variable material itself, but combining the optically variable material with at least one feature substance that is easily and reliably machine-readable while not impairing the visible, optically variable effect of the optically variable material".

Here, Plaschka clearly suggests using two different security elements for a specific purpose: The security element should be provided not just with an optically variable security element, but also with a security element which is machine-readable. This is something completely different than the present invention.

As the examiner admitted, there is no explicit teaching whatsoever in Plaschka to use the same security element in at least two different constituting parts of a security document. It is certainly correct that Plaschka shows, in two completely different embodiments, that its security elements can be used in different constituting parts of the security document. However, this is a well-known fact and has nothing to do with the present invention. There is no suggestion or motivation in Plaschka to use exactly the same security element in two different constituting parts. A rejection on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). We therefore respectfully submit that the conditions of MPEP 2143.01 for a finding of prima facie obviousness are not fulfilled.

What Plaschka does is to improve protection against counterfeiting by providing an additional, different security element. As mentioned above, this was a well known way of improving protection against counterfeiting. The present invention, on the other hand, provides a different way of improving protection against counterfeiting. We respectfully submit that this completely different concept is not mentioned or suggested at all in Plaschka, and thus Plaschka does not make obvious the additional and improved possibility of protection against counterfeiting taught by the present invention.

We believe the claims now presented are patentable over the prior art and that this application is now in condition for allowance.

Respectfully submitted,

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